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PRE-APPEAL BRIEF REQUEST FOR REVIEW	Docket No.: 99486-US-CIP XERZ 2 531-3
Application No.: 09/496,698	Filed: February 2, 2000
Title: DOCUMENT PRODUCTION SYSTEM FOR CAPTURING WEB PAGE CONTENT	
First Named Inventor: Andrew D. Simchik et al.	
Art Unit: 2622	Examiner: Joseph R. Pokrzywa

Applicant(s) request(s) review of the final rejection in the above-identified application. No amendments are being filed with this request.
This request is being filed with a notice of appeal.
The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)
- ☒ attorney or agent of record.
- ☐ attorney or agent acting under 37 CFR 1.34.

Respectfully submitted,
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Date: 1/24/06

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NOTE: Signature(s) of all the inventor(s) or assignee(s) of record of the entire interest or their representative(s) is/are required. Submit multiple forms if more than one signature is required, see below*.

☒ *Total of 1 forms are submitted.

CERTIFICATE OF MAILING

I hereby certify that this Pre-Appeal Brief Request for Review and accompanying documents are being

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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF	:	Andrew D. Simchik, et al.
FOR	:	DOCUMENT PRODUCTION SYSTEM FOR CAPTURING WEB PAGE CONTENT
SERIAL NO.	:	09/496,698
FILED	:	February 2, 2000
GROUP ART UNIT	:	2622
CONFIRMATION NO.	:	6586
EXAMINER	:	Joseph R. Pokrzywa
NOTICE OF APPEAL FILED	:	October 24, 2005
ATTORNEY DOCKET NO.	:	99486-US-CIP XERZ 2 00531-3

SUPPLEMENTAL PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
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Brobst et al. '700

By way of review, Brobst et al. '700 is an apparatus and method for formatting a specified group of related web pages into a single web page. The user will define a number of selected pages and associated relation criteria for each selected page. The formatting mechanism will collect the URLs for the selected pages, and store the URLs into a URL container. The formatting mechanism will further invoke each web page associated to the URLs contained in the URL container and generate a conglomerate page. The conglomerate web page may include data inserted into or referenced in one or more of the selected pages. The conglomerate web page may then be printed using a standard browser print function. Thus, Brobst et al. takes a variety of URLs and flattens them into a flattened conglomerate page.

The concepts of the Brobst et al. '700 Patent is based on the acknowledgment that, with the number of Internet users expanding, "it will become increasingly important for a web browser to print related web pages without manually invoking and printing

each page." Because, "without improvements in the manner web pages are printed, the printing of web pages will continue to be an impediment to the effective usage of resources available on the Internet." (column 1, lines 57-64).

On the other hand, the present application is directed to a method of converting a page from a network into an image file suitable for assembly or insertion into a document generated by a document creation algorithm. The present system will therefore take a network page (*i.e.*, web page) and convert the content of the page into an image file suitable for insertion into the document. By this design, the user may create a document including a content of a web page. Then when a next user retrieves the created document, updated content from the web page will be inserted into the document by access to the URL link.

Claims 8-12

An element of Applicants' claim 8 is that the method includes the following step: "automatically converting the content of the page into an image file suitable for insertion into the document." The Examiner's 35 U.S.C. § 102 rejection is based on two locations in the '700 Patent which it is alleged teaches the above claimed concepts.

The first location from the Brobst et al. '700 Patent is column 6 lines 17-42. Although the reference refers to a "web page formatting mechanism", this mechanism does not convert the content of the web page (*e.g.*, an HTML file) into an image file suitable for insertion into the document as specified in the Applicants' claim 8. Applicants, in claim 8, specify a method for "automatically converting the content of the page into an image file suitable for insertion into the document." This conversion is not taught in the prior art by column 6 lines 17-42 of the Brobst et al. '700 Patent, rather Brobst et al. simply combines an html web page with an existing web page which is also in html format. Brobst et al. does not teach or fairly suggest the conversion of the web page before inserting it into a compilation file which is printed.

The second cited location is column 7, line 10 to column 8, line 16. This discussion does not address conversion of a webpage. Instead this reference deals with the prior art's "digging" element. Digging refers to the ability for the system to find the webpage selected by the user and then to dig and retrieve the web pages that are hyperlinked within the user specified web page. Furthermore, web pages that are "dug up" from the user specified web page can be analyzed for hyperlinks and these web

pages can be retrieved. This would be an example of digging two levels down from the user specified web page. Applicants submit this discussion does not teach or suggest the concepts of claim 8, which require the conversion of a web page. Applicants clearly state in their specification that "conversion" is the process of converting the page (*e.g.*, HTML) file into a printer friendly format such as PDL which is then converted, often by the printing device, into the image file for printing. See page 2, line 13-17 and page 7, lines 11-23. In no way does Applicants' element refer to the process of digging and collecting the underlying web pages which are hyperlinked within the user selected web pages.

Applicants argue that at least for the reasons that neither of the references cited teach the limitation of "automatically converting the content of the page into an image file suitable for insertion into the document," that Brobst et al. '700 does not anticipate all of the limitations in Applicants' claim 8, and request the 102 rejection be withdrawn and claim 8 and its dependent claims 9-12 be made ready for allowance.

Claim 27

Applicants respectfully submit the concepts of claim 27 are also not taught or fairly considered by the cited art. Particularly, in that claim, it is recited that the content of the page is inserted into the document, whereby when the document is "printed into a hardcopy format, the content of the page is printed into the hardcopy format as part of the document." It is submitted the cited Brobst et al. '700 Patent is simply designed to provide a flattened URL page, and not to provide the creation of a hardcopy document whose content will be printed in a hardcopy form.

Claims 28-31

Applicants claim 28 is rejected based on 35 U.S.C. § 102 for similar reasons as claim 8. The final element of the system claimed in claim 28 is "a production agent for automatically converting the content of the network page into an image file and for automatically inserting the content into the document." The Brobst et al. '700 Patent is again cited, and column 6 lines 17-42 and column 7 line 10 through column 8 line 16 are pointed to. These discussions are identical to the discussions used against claim 8's element.

The first citation from Brobst et al. '700 is column 6 lines 17-42. Although the citation refers to a "web page formatting mechanism", this mechanism does not convert a network page into an image file as specified in the Applicants' claim 28. Applicants in claim 28 specify a method for "a production agent for automatically converting the content of the network page into an image file and for automatically inserting the content into the document." This conversion into a printable format step of the Applicants' claim 28 in not taught in the prior art by column 6 lines 17-42 of the Brobst et al. '700 Patent referenced by the Examiner, rather Brobst et al. simply combines an html web page with an existing web page which is also in html format. Brobst et al. does not teach the conversion of the web page before inserting it into the compilation file which is printed.

The second reference citation is to column 7, line 10 to column 8, line 16, and does not address conversion of the network page. Instead this reference deals with the prior art's "digging" element. Digging refers to the ability for the system to find the webpage selected by the user and then to dig and retrieve the web pages that are hyperlinked within the user specified web page. Furthermore, web pages that are "dug up" from the user specified web page can be analyzed for hyperlinks and these web pages can be retrieved. This would be an example of digging two levels down from the user specified web page. Applicants argue that this reference is improper to be cited against claim 28, which requires the conversion of the network page. Applicants clearly state in their specification that "conversion" is the process of converting the HTML file into a printer friendly format such as PDL which is then converted, often by the printing device, into the image file for printing. See page 2, line 13-17 and page 7, lines 11-23. In no way does Applicants element refer to the process of digging and collecting the underlying web pages which are hyperlinked within the user selected web pages.

Applicants submit that because neither of the Examiner's references teach the limitations of "a production agent for automatically converting the content of the network page into an image file and for automatically inserting the content into the document," that the all element rule of MPEP 2131 is not met and therefore the Brobst et al. '700 Patent reference does not anticipate all of the elements in Applicants claim 28. Applicants argue that the Examiner's references are incorrect and ask that the 35

U.S.C. § 102 rejection be withdrawn and claim 28 and its dependent claims 29-31 be made ready for allowance.

Claim 29

Claim 29 is dependent upon claim 28 and teaches a system where upon "subsequent access of the document, the browser launches automatically accessing and retrieving the most recently updated content of the network page without need for action or knowledge by the user." This element is not taught by the Brobst et al. '700 Patent. Although the '700 Patent does retrieve web pages, no where is it taught that upon "subsequent access" the system goes out and retrieves the most recent web pages. Instead, the '700 Patent reference (column 6, line 54-colunm 7, line 19) teaches the process of digging, creating a nesting structure, and retrieving the associated web pages. Also, the ' 700 Patent reference (column 8, line 17-31) refers to the URL container and how when it is modified with an additional URL the "new page is then added to the flattened page file." The 700' Patent's system does not re-retrieve the previously retrieved URLs and only retrieves the most recent web page for the newly added URL. Therefore both citations to the '700 Patent fail to teach the concepts claimed by the Applicants' claim 29.

For at least the above-stated reasons, Applicants respectfully request a pre-appeal review for the reasons set forth above.

Respectfully submitted,

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Under 37 C.F.R. § 1.8, I certify that this Pre-Appeal Brief Request for Review and accompanying document(s) are being

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Date: January 24, 2006 By: Karen M. Forsyth

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